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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,567	11/13/2000	Edward F. Tokas	031221-058	8260

21839 7590 10/04/2002

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/711,567	<b>Applicant(s)</b> TOKAS ET AL.	
	<b>Examiner</b> Geoffrey L. Knable	<b>Art Unit</b> 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 84-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 84-92 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 &amp; 5</u> . | 6) <input type="checkbox"/> Other: ____                                     |

Art Unit: 1733

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 84, 85 and 87-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US 5,137,785).

Suzuki discloses a composite including a metathesis polymer that may be located between upper and lower substrates (col. 6, lines 21-26), the metathesis polymer is such case forming an adhesive interposed between the substrates. Further, the substrates can be thermoplastic elastomer. As to claim 84, insofar as the final

product is being claimed rather than the process of its formation, it is submitted that the cured metathesis polymer of the reference would not be patentably distinguished from the article claimed.

5. Claims 84-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muhlebach et al. (US 5,973,085) taken with Ofstead (US 3,935,179) and Suzuki et al. (US 5,137,785).

Muhlebach et al. (note esp. col. 2, lines 12-35) and Ofstead (note esp. col. 2, lines 25-28) disclose metathesis polymers useful as adhesives and that possess very high bonding strengths even to metal. Suzuki et al. provide evidence further that it is known that metathesis polymers can effectively bond to elastomer materials. In light of the known application of metathesis polymers as adhesives in general with apparently broad applicability as well as the known fact that these polymers bond effectively to various materials including elastomer and metals, it would have been prima facie obvious to utilize metathesis polymers anywhere an adhesive between materials is needed including in particular when metal and/or elastomer materials are to be bonded. Further, as to the tire laminate claims, note that it is well known to use an adhesive composition between the tread and tire particularly in retreading, the use of the claimed materials being obvious for the same reasons absent some showing of unexpected or unobvious results.

6. Claim 84 rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 5,137,785) or Muhlebach et al. (US 5,973,085) taken with Ofstead (US


3,935,179) and Suzuki et al. (US 5,137,785) as applied above, and further in view of Lesser (US 2,978,354).

Although it is not believed that the manner of introduction of the catalyst leads to a materially different product, even if it were considered that it did, it is submitted that it would have been an obvious alternative to first apply the catalyst to the substrate surface rather than mixed with the polymer as it is well known in the formation of catalyzed polymer layers to either apply the catalyst with (or at the same time as) the polymer or to alternatively apply the catalyst initially to the surface in order to avoid problems of reduced pot life, etc. – Lesser is exemplary.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable  
Primary Examiner  
Art Unit 1733

G. Knable  
October 1, 2002